

REMARKS

This Response After Final Office Action is submitted in reply to the Final Office Action dated January 21, 2009 and the Advisory Action dated April 10, 2009. Claims 1, 19, 33, and 41 have been amended for clarity. No new matter is added by these amendments. Claims 9, 10, 14, 15, 17, 26 to 28, and 30 stand cancelled. A Request for Continued Examination is submitted herewith. The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees due in connection with the Request for Continued Examination and this Response.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner provide an upcoming Office Action which will “. . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable” in accordance with §707.07(d) of the MPEP.

The Office Action rejected claims 1 to 8, 11 to 13, 16 to 25, 29, and 31 to 47 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0181234 to Falciglia, SR. (“Falciglia”) in view of U.S. Patent Publication No. 2003/0073480 to Thomas et al. (“Thomas”) and further in view of U.S. Patent No. 5,401,024 to Simunek (“Simunek”). Applicant respectfully disagrees and traverses this rejection.

Amended independent claim 1 is directed to a gaming device including, among other elements, a plurality of instructions which when executed by at least one processor, cause the at least one processor to operate with at least one display device and at least one input device, for a play of the game, to cause an additional second award to be provided, the additional second award being based on whether a first symbol is generated for the play of the game, the additional second award being determined based on an outcome of a bonus event, the outcome of the bonus event determined after a first generation by each of a plurality of random symbol generators,

the first generation including a generation of the first symbol, and before a subsequent second generation by each of the random symbol generators.

Applicant respectfully submits that though the Office Action rejected claim 1 over Falciglia in view of Thomas and further in view of Simunek, the Office Action did not indicate where the combination of those references disclose causing an additional second award to be provided, the additional second award being determined based on an outcome of a bonus event, the outcome of the bonus event determined after a first generation by each of the random symbol generations, the first generation including a generation of the first symbol, and before a second generation by each of the random symbol generators. Specifically, the Office Action stated that:

Falciglia discloses the claimed invention as discussed above but is silent in regards to claim[] 1...the additional second award being determined based on an outcome of a bonus event, the bonus event occurring after a first generation by each of the random symbol generators and before a second generation by each of the random symbol generators.

Applicant respectfully submits that the Office Action did not thereafter indicate where, in the combination of Falciglia, Thomas, and Simunek, the underlined element is found. After admitting Falciglia's deficiencies, the Office Action did not state that Thomas or Simunek alone, nor the combination of Thomas and Simunek, discloses the additional second award being determined based on an outcome of a bonus event, the outcome of the bonus event determined after a first generation by each of the random symbol generations, the first generation including a generation of the first symbol, and before a second generation by each of the random symbol generators.

The Advisory Action stated that:

The reference of Simunek was cited to teach a bonus event wherein a player selects a predetermined number of spot and the selected spots are matched by one of the randomly generated spot. If the player "super spot" is selected by one of the randomly generated spots than a bonus event occurs. A multiplier is randomly generated and used to multiply the player's other matched spot winning by the multiplier to determine a bonus pay off. The base reference of Falciglia discloses that a player has a predetermined number of spins to play a game. By combining Falciglia's predetermined number of spins and after the first spin a additional second award being determined on an outcome o a bonus event to the base game as taught by Simunek, one of ordinary skill in the art would provide a

user with an opportunity to increase the size of the payout outcome. Regardless upon where a bonus event occurs after the spin or after every individual spin of every reel, column or section, the outcome will still be the same of providing a player with an opportunity to increase the size of the payout outcome.

Applicant respectfully disagrees, and states that neither Falciglia, Thomas, or Simunek alone, nor the combination of Falciglia, Thomas, and Simunek, discloses or renders obvious the additional second award being determined based on an outcome of a bonus event, the outcome of the bonus event determined after a first generation by each of the random symbol generations, the first generation including a generation of the first symbol, and before a second generation by each of the random symbol generators.

Applicant submits that the Advisory Action improperly failed to recognize that Falciglia teaches away from the combination of Falciglia and Thomas suggested by the Advisory Action. Specifically, Applicant submits that one of ordinary skill in the art would not have modified Falciglia to result in the gaming device of amended independent claim 1, because Falciglia discloses a game wherein a play of the game spans a plurality of different spins of the reels. That is, Falciglia discloses a game that "allows the player three spins to attain a winning outcome. The overall goal is to cover all the squares in one or more rows on the game board within the allotted three spins." (¶8, ll. 3-6). Thus, Falciglia teaches away from any modification wherein the flow of the game (i.e., the three spins to attain the winning outcome) is broken-up or disrupted, such as to play a bonus game. Applicant submits that regardless of whether Simunek discloses a bonus event, as stated by the Advisory Action, Falciglia teaches away from any modification that incorporates the bonus event of Simunek between spins of Falciglia, but prior to the end of the game of Falciglia. Thus, the combination of Falciglia and Simunek does not disclose or render obvious the additional second award being determined based on an outcome of a bonus event, the outcome of the bonus event determined after a first generation by each of the random symbol generations, the first generation including a generation of the first symbol, and before a second generation by each of the random symbol generators.

The Advisory Action also stated that "Regardless upon where a bonus event occurs after the spin or after every individual spin of every reel, column or section, the outcome will still be the same of providing a player with an opportunity to increase the size of the payout outcome." Applicant respectfully disagrees, and states that one of ordinary skill in the art would understand that a gaming device including a plurality of instructions which, executed by at least one processor, cause an additional second award to be provided, the additional second award being determined based on an outcome of a bonus event, the outcome of the bonus event determined after a first generation by each of the random symbol generators, the first generation including a generation of the first symbol, and before a second generation by each of the random symbol generators, increases player excitement and enjoyment because the player potentially receives increasing bonus awards throughout the play of the game rather than solely after the play of the game. Thus, Applicant states that regardless of whether the actual outcome provided to the player is quantitatively the same (e.g., the same number of credits is provided), the function of the gaming device of claim 1 is substantially different than the gaming device resulting from the combination of Falciglia and Simunek. In addition, Applicant has amended independent claim 1 to include clarify that the instructions cause the processor to cause a number of generations by each of the random symbol generators, said number of generations being greater than one. Thus, Falciglia in view of Simunek does not disclose or render obvious amended independent claim 1.

For at least the reasons given above, Applicant submits that independent claim 1 patentably distinguished over Falciglia, Thomas, and Simunek, and is in condition for allowance.

Dependent claims 2 to 8, 11 to 13, 16, and 18, which depend directly or indirectly from independent claim 1, are also allowable for the reasons given above with respect to independent claim 1, and because of the additional features recited in these claims.

Amended independent claims 19, 33, and 41 (and dependent claims 20 to 25, 29, 31, 32, 34 to 40, and 42 to 47, which depend directly or indirectly from independent claims 19, 33, or 41) each include certain similar elements to claim 1. For reasons

similar to those given above with respect to claim 1, and because of the additional features recited in independent claims 19, 33, and 41 (and dependent claims 20 to 25, 29, 31, 32, 34 to 40, and 42 to 47) are patentably distinguished over Falciglia in view of Thomas and further in view of Simunek, and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art, such allowance is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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